

REMARKS

This amendment is submitted in response to the final Office Action mailed May 11, 2006. In the Office Action, the Examiner:

- withdrew the rejections of pending claims 1-4, 6, 9, 10-12, 13-19, 20-22 and 30-32 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,257,993 to Asher et al. (hereinafter "Asher");
- withdrew the rejections of claims 18 and 34 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 56,406,477 to Fujiwara (hereinafter "Fujiwara");
- rejected pending claims 1-9, 13-17, 23-29 and 33 under 35 U.S.C. § 102(e) as anticipated by Fujiwara; and
- objected to claims 18 and 34 as being dependent upon a rejected base claims but otherwise allowable if rewritten in independent form.

Following entry of this amendment, claims 1-34 remain pending in the application. Applicants have amended claims 1 and 23 to place the application in condition for allowance by more clearly distinguishing over the cited prior art. Applicants have also amended claim 27 to correct a minor grammatical error. All amendments are fully supported by the originally-filed specification and/or drawings of the present application. No new matter has been added. The claim amendments made herein do not represent acquiescence in the Examiner's rejections, but rather are made only to expedite prosecution of the present application and/or maintain consistency in claim language. Applicants expressly reserve the right to pursue the subject matter of any previously presented claims in one or more continuation applications. As discussed more fully below, Applicants respectfully submit that each of the currently pending claims define features that are not disclosed, taught or suggested by the prior art of record and respectfully request allowance of same.

Claim Rejections - 35 U.S.C. § 102(e)

Claims 1-9, 13-17, 23-29 and 33 were rejected as anticipated by Fujiwara. Applicants respectfully traverse these claim rejections and, for the reasons discussed below, submit that Fujiwara does not disclose, teach or suggest each of the limitations recited in

amended independent claims 1 and 23.

As amended, independent claim 1 recites a bone fixation system for coupling a first fracture fixation implant to a second fracture fixation implant defining a longitudinal axis, comprising, *inter alia*, a body member including “at least one prong extending from the body member for contacting a surface of the second implant when in an *engaged* position to substantially prevent rotation of the second implant while *simultaneously* permitting sliding of the second implant with respect to the first implant along the longitudinal axis.” Support for this amendment is found throughout the originally-filed specification of the present application, as shown below:

[F]irst and second stops 92, 94 may be selectively spaced apart along longitudinal axis 30 to provide for *a desirable amount of sliding between implant 20 and intramedullary nail 22*, such as to provide for compression between the two fractured bone fragments.

(Specification at Para. [0055]; *see also* Para. [0047].) Claim 23 has been similarly amended.

Applicants respectfully submit that these amendments clarify that the claimed device includes a prong that, *when engaged*, prevents rotation of the second implant with respect to the first implant, while *simultaneously* permitting sliding of the second implant with respect to the first implant. In this regard, applicants also note that the February 23, 2006 Amendment in response to the November 1, 2005 Office Action emphasized that the claimed invention distinguished over the cited prior art because the prior art “did not disclose a prong that, *when engaged*, permits relative sliding of implants, as recited in independent claim 1.” (See February 23, 2006 Amendment at 9 (emphasis added).)

In considering applicants’ arguments concerning Fujiwara in the February 23, 2006 Amendment, the Office Action states that

Fujiwara ‘477 still discloses a first implant (16) and a second implant (32), and also still has at least one prong. Also the second implant also is capable of forming a longitudinal axis that likewise has the capability of sliding movement. *Sliding must occur at one point in the device’s setup to arrange it as needed, even if it when sliding the second implant through the first implant in preparation for it to be secure.*

(May 11, 2006 Office Action at 2 (emphasis added).) These remarks cite the relative sliding of implants in Fujiwara *prior to engagement* of the spacer 46 with lag screw 22. But Fujiwara clearly does *not* disclose a device including a prong that, *when engaged*, permits relative sliding of implants, as recited in independent claim 1. Fujiwara discloses an

intramedullary nail and lag screw assembly including a spacer 46 that, when engaged, prevents *both* sliding and rotation of the lag screw with respect to the nail:

[T]he set screw 42 pushes down the whole of the spacer 46 and the lower ends of the legs 46b come into engagement with the grooves 34 of the lag screw 22, thereby securing the lag screw 22 in the nail member 16 while at the same time preventing the rotation of the lag screw 22. Even in the case where the grooves 34 are not formed on the periphery surface of the lag screw 22, the lag screw 22 can be secured in the nail member 16 by being clamped between the nail member 16 (particularly the surface of the main through hole 24) and the spacer 46 due to the friction between the lower ends of the legs 46b of the spacer 46 and the peripheral surface of the lag screw 22.

(Fujiwara at col. 5, lines 20-33 (emphasis added).) Therefore, Fujiwara fails to disclose a device having the claimed “at least one prong extending from the body member for contacting a surface of the second implant when in an *engaged* position to substantially prevent rotation of the second implant while *simultaneously* permitting sliding of the second implant with respect to the first implant along the longitudinal axis,” as recited in independent claim 1. Similarly, Fujiwara fails to disclose a device having first and second prongs that “permit sliding of the second implant with respect to the first implant along the second longitudinal axis while at least one of the first and second prongs *simultaneously engages* the second implant,” as recited in independent claim 23.

Accordingly, since Fujiwara fails to disclose, teach or suggest all of the elements recited in amended claims 1 and 23, applicants respectfully request that the anticipation rejection of claims 1 and 23 be withdrawn and that these claims, and each of their dependent claims 2-22 and 24-33, be allowed.

Allowable Subject Matter

The Office Action indicates that claims 18 and 34 are objected to as being dependent upon a rejected base claim, but otherwise allowable if rewritten in independent form. However, applicants note that claim 34 was previously amended to appear in independent form, so applicants respectfully request withdrawal of any objections to claim 34 and allowance of same.

Applicants also note that while the Office Action Summary states that claims 1-17 and 19-33 have been rejected, the May 11, 2006 Office Action only rejected claims 1-9, 13-17, 23-29 and 33 based on Fujiwara. Claims 10-12, 19-22 and 30-32 were not rejected based on Fujiwara, or any other prior art reference. Accordingly, applicants also respectfully

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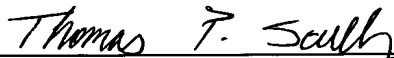
request allowance of claims 10-12, 19-22 and 30-32.

In view of the above, Applicants respectfully submit that claims 1-34 are now in condition for allowance. The Examiner is invited to call the undersigned attorney at (212) 326-3939 if a telephone call could help resolve any remaining issues.

No fees are believed due with this submission. However, should any additional fees be required, please charge such fees to Jones Day deposit account no. 50-3013.

Respectfully submitted,

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